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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,298	12/07/2004	Takanori Fukushima	TSUZ 2 00019	4483

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EXAMINER	
VIJAYAKUMAR, KALLAMBELLA M	
ART UNIT	PAPER NUMBER
1793	
MAIL DATE	DELIVERY MODE
02/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/517,298	FUKUSHIMA ET AL.	
	Examiner	**Art Unit**	
	KALLAMBELLA VIJAYAKUMAR	1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): ODP over 10/567,740.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-5*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Stanley Silverman/
Supervisory Patent Examiner, Art Unit 1754

Continuation of 11. does NOT place the application in condition for allowance because:
Applicants arguments filed 01/28/2008 have been fully considered and fail to overcome the rejections cited in the Final Rejection mailed 11/29/2007 for the following reasons:
With regard to the argument that "examples/composites as disclosed in Chen does not contain an ionic liquid <Res, Pg-2, Last Para> and the composite is in the form of a thin film (i.e. solid, not gel) (see ¶ [0038], [0049]). Ionic liquids are exemplified simply as a solvent for composing an electrolyte for use in the electrochemical polymerization (see ¶ [0040]) and thus are to be removed by washing from the final products (composite films)" <Res, Pg-4, Para-1>, the prior art teaches electropolymerization of components containing electrolyte that includes ionic liquids, forming gelatinous film containing the solvent (US 2003/0077515, Pg-4, P-0049; last 3-line). The prior art further teaches transferring electrodes coated with the film to deareated electrolyte i.e. using the films without washing (P-0101); and disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).
With regard to the argument that "There is no suggestion in Chen of a gel composition "consisting of" CNT and ionic liquid.", <Res, Pg-4, Para-1>, that is not the limitation of the instant claim, and the instant claim limitation of "comprising" does not exclude the addition of other components in the composition including the solvent present in Chen's gelatinous film, and although that claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims. Raytheon Co. v. Roper Corp., 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984). Further, removal of the ionic-liquid/electrolyte from the gel upon its formation is not precluded from the instant claim limitation.
With regard to the argument that "there is no suggestion in the Chen reference that a gel may be formed in the step of preparing the dispersion" <Res, Pg-3, Para-2>, that is not the limitation of the instant claims.
With regard to the argument that Chen uses ionic liquids as solvents, the prior art teaches its use as a solvent/electrolyte in the composition, and It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).
With regard to the argument about method in claim-3, "Chen makes no suggestion of these three elements: a carbon nanotube (1) and an ionic liquid (2) which are pulverized under a shearing force (3)" <Res, Pg-5, Para-3>, it depends on the composition whereby the composition produced by that method step will be either same or substantially same as produced by this method step, and furthermore the prior art teaches using ultrasonic during electropolymerization that provides a shearing force (P-0038). With regard to the application of external force being applied during coating in claim-5 <Res, Pg-5, Para-4>, the prior art teaches the application of electromotive force in forming a film.

For the reasons set forth above, applicants fail to patentably distinguish their composition and methods over the prior art.

/KMV/
Februaruary 08, 2008.